

## **REMARKS**

In the present non-final Office Action, Examiner Ramana rejected the pending claims over the Beyar reference (US 6,127,597). Although it is believed that the claims distinguish over the reference as they stand, as discussed in a prior filing, in order to move this case more quickly to allowance, the present amendments and remarks are offered. Examiner Ramana is respectfully requested to telephone the undersigned attorney to set up an interview when she is ready to take up this case.

Claim 37 is being amended as noted above to recite first and second surfaces of the expandable device and their physical relationship with recited features. Support for these amendments is found, among other places, in Figures 1-20 and related text. As one example, Figures 1-2 show at least one first surface (lower side of item 32 and/or upper side of item 42) that generally faces cavity 40, and at least one second surface (surface(s) on which teeth 38, 48 are found) that generally faces away from cavity 40. No part of the surface on which teeth 38 are found faces the lower side of item 32, as one example.

Item 130 of Beyar does not show such structure. In order for it to operate as taught in the reference, its outward-facing surface moves under and must face its inward-facing surface in order to have its teeth interengage. When it is expanded, at least the underneath part of its outward-facing surface must move along the inward-facing surface, so that the teeth can interengage in a variety of locations.

Claims 38-40, 42-49 and 51-52 depend from claim 37, and are allowable based on that dependence and/or on their own merit as noted in prior responses. Further, claim 43 recites that the portions are uni-directionally movable away from each other on expansion of the expandable element. The Beyar device appears to move all of its device in many directions, including the

left side as seen in the Beyar drawing to the left, the unattached right sides along each other, and the top and/or bottom to the left to accommodate the expansion. That multi-directional movement does not anticipate claim 43.

Beyar also does not show the differing height separations recited in claim 44. The Beyar device must have a constant height at both of its open ends because of the interengaging splines or teeth on its interior and exterior surfaces. If the heights differ at those open ends, then the longitudinal splines will not mesh with each other. Taken the other way, the longitudinal splines must mesh in order for Beyar's device to operate, necessitating the constant height at both ends. For the same reason, Beyar does not and cannot show the tapered configuration recited in claim 45, or the stepped configuration recited in claim 46.

Claim 55 is being amended as noted above to recite that the filler material is within the expandable element. Support for that language is found at least at paragraph 54 of the application as published. Beyar does not show or suggest that feature, and it is believed that none of the references of record disclose or suggest it.

Claims 56-62 and 64-65 depend from claim 55 and are allowable based on that dependence and/or on their own merit as noted in prior responses. Further, claims 58-60 include language similar to that of claims 44-46. These claims are not anticipated by the Beyar device, which depends for its operation on the engagement of its splines and the necessarily resulting identical heights of its open proximal and distal ends.

New independent claim 68 is being offered, which recites among other things first and second surfaces in which the second surface does not move along the first surface. Support for this language is found at least in Figures 1-20 and related text. As one example, Figures 1-2 show at least one first surface (lower side of item 32 and/or upper side of item 42) that generally

faces cavity 40, and at least one second surface (surface(s) on which teeth 38, 48 are found) that generally faces away from cavity 40. Expansion of element 55 moves those surfaces, but not along each other. For instance, the surface on which teeth 38 are found does not move along the lower side of item 32, as one example.

The Beyar device, however, is a folded or coiled device that depends on movement of one surface along another for its operation. Referring to Beyar's Figure 13C, unless the two surfaces with teeth or splines move along each other, there can be no expansion of the device. The relative movement of the surfaces is what permits not only expansion but maintenance of that expansion through engagement of the splines. Thus, Beyar does not disclose, and in fact teaches away from, the noted language of claim 68. For these and other reasons given in prior filings, claim 68 should be allowed.

New claims 69-70 depend from claim 37. Support is found in at least paragraph 54 of the application as published. Beyar does not disclose or suggest injection of bone growth material into an expandable element to expand an expandable device. Beyar suggests an inert polymer that can solidify, but only after its item 130 has been expanded by other means. It does not suggest an active bone growth material to expand and promote fusion at once.

New claim 71 depends from claim 55, and its language is similar to language in claim 37, discussed above. Support for this language is as previously noted. It is allowable over Beyar based on its language and its dependence from claim 55.

### Conclusion

It should be understood that the above remarks are not intended to provide an exhaustive basis for patentability or concede the basis for the rejections in the Office Action but are simply

provided to address the rejections made in the Office Action in the most expedient fashion.

Applicant reserves the right to later contest positions taken by the examiner that are not specifically addressed herein. No narrowing amendments have been made, and no narrowing of the scope of the claims via the remarks above is intended or should be inferred.

Reconsideration and passage to allowance in view of the above remarks is respectfully requested. Should it be determined that any further issues are outstanding, Examiner Ramana is encouraged to telephone the undersigned.

Respectfully submitted,

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